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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,002	10/26/2000	John W. Gibson	S0351/249009	7722

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EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/699,002

Applicant(s)

GIBSON ET AL.

Examiner

Barbara P Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 88 and 89 is/are pending in the application.
- 4a) Of the above claim(s) 89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**First Office Action on the Merits**

***Election/Restrictions***

1. Applicant's election with traverse of Group III in Paper No. 4 is acknowledged. The traversal is on the ground(s) that it is improper for the examiner to withdraw a portion of the claim from consideration. This is not found persuasive because according to MPEP § 803.02 restriction of a Markush-type claim is improper if "the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden". In the present application, the Markush claim contains seven vastly different structures having various R groups consisting of a number of different groups. Therefore, the members of the instant Markush claim are not few in number nor are they closely related. Thus, a search of the entire claim would post a serious burden on the examiner. Applicant cites *In re Weber* and *In re Haas* in support of his argument. However, the cases cited by applicant states "it is improper for the Office to refuse to examine that which applicants regard as their invention, **unless the subject matter in a claim lacks unity of invention**". The subject matter of the instant invention lacks unity of invention and, thus, restriction is proper.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Based on applicant's election of Group III, claim 88 will be examined to the extent it reads on compounds of formula IV. Claim 89 stands withdrawn from further consideration as being drawn to a non-elected invention.

***Information Disclosure Statement***

3. The information disclosure statement filed October 26, 2000 is noted and will be considered once the references become available from the parent case.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

m 5. Claim 88 is rejected under 35 U.S.C. 102(b) as being anticipated by Noda et al. ('405).

Noda et al. teach D-fructopyranose  $\beta$ -1,3,4,5-tetraacetate (col. 6, line 28). The compound taught by the reference is encompassed by the instant claim.

w 6. Claim 88 is rejected under 35 U.S.C. 102(b) as being anticipated by Swiderski et al.


Swiderski et al. teach D-fructopyranose  $\beta$ -pentaacetate, RN 20764-61-8 (see the attached Abstract). The compound taught by the reference is encompassed by the instant claim.

***Telephone Inquiry***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Barbara P Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
March 12, 2002